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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,995	03/24/2004	Richard Ormson	P/126-229	4648

2352 7590 08/16/2006

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NEW YORK, NY 100368403

EXAMINER

HUYNH, NAM TRUNG

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 08/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/807,995	ORMSON, RICHARD	
	Examiner	Art Unit	
	Nam Huynh	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17 is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This office action is in response to amendment filed on 8/1/2006. None of the claims were amended.

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4, 6-13, and 15-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Ostberg et al. (US 2004/0203839).
 - A. Regarding claims 1, 6-8, 10, and 15-16, Ostberg et al. discloses a mobile terminal capable of identifying cellular control channels that can be received by the mobile terminal from a cellular system, by identifying a cellular control channel that can be received from a history list of cellular control channels that were previously received by the mobile terminal (abstract). In the scope of the invention, the mobile terminal performs a cell search on frequencies in a history list stored in the mobile terminal of carrier frequencies the mobile terminal used last time it was active (page 3, paragraph

31). This history list may include a list of control channels that were used last time the mobile terminal was activated and in other embodiments, the history list may contain a list of control channels (cell information) that were used in a next to last activation and/or additional prior activations of the mobile terminal (prior first and second separate instances of network loss) (page 4, paragraph 35). Prior activations can be interpreted as a "network loss", since a lack of service or communication is necessary in order to initiate activation. After the history list is searched (figure 9, item 906) and enough WCDMA cells are found (figure 9, item 910), then the mobile terminal will decide on Active RAT (Radio Access Technology) (camp) and/or perform an alternate search (network search) on WCDMA and other RAT (figure 9, item 964).

B. Regarding claims 2, 4, 11, and 13, Ostberg et al. discloses a variable size "L" of the history list (figure 9, item 906).

C. Regarding claims 3 and 12, Ostberg et al. discloses that the invention can also include different and/or additional stop criteria such as a timeout criteria (page 5, paragraph 51).

D. Regarding claim 9, Ostberg et al. discloses that the mobile terminal performs a cell search on frequencies in a history list stored in the mobile terminal of carrier frequencies the mobile terminal used last time it was active (page 3, paragraph 31). In regards to the radio access technology, Ostberg et al. discloses that other criteria besides control channels may be used to indicate preferred channels in the history.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 5 and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Ostberg et al. (US 2004/0203839) in view of Wiberg et al. (US 6,628,946).

Ostberg et al. discloses the limitations set forth in claim 1, but does not explicitly disclose that previously stored details are identified. Weiberg discloses a system and method for storing tags during a cell change in which a determination is made of whether the tag sent from the new cell has previously been stored (figure 10, items 103, 105, 109). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the history list of Ostberg et al. to include a determining means of previously stored data, as taught by Wiberg et al., in order to conserve memory and radio resources by preventing the storage of duplicate data.

Allowable Subject Matter

7. Claim 17 is allowed.

Response to Arguments

8. Applicant's arguments filed 8/1/2006, with respect to the rejection(s) of claim(s) 1-16 under 35 USC § 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made above.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nam Huynh whose telephone number is 571-272-5970. The examiner can normally be reached on 8 a.m.-5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NTH
8/11/06


GEORGE ENG
SUPERVISORY PATENT EXAMINER